REMARKS

Claims 47 and 48 are added, and therefore claims 22 to 48 are currently pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4), claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 were rejected under 35 U.S.C. § 102(e) as anticipated by Peinado et al., U.S. Patent No. 7,051,005.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The Peinado reference only refers to a method where, after receiving the second data, the second processor transmits a decryption key to the first processor (see column 3 lines 43-54), but it does not identically disclose (nor suggest) any method in which the second processor sends the first processor a check result, ordinarily understood as only a piece of data indicating that the first processor has permission to process the first data. Because Peinado does not disclose a method where the second processor transmits a check result, it does not and cannot anticipate claim 22, so that claim 22 is allowable.

Claims 23, 25 to 33, 35 to 40, 45 and 46 depend from claim 22 and are therefore allowable for the same reasons as claim 22.

Independent claims 24, 34, and 41 to 44 include features like those of claim 22, and are therefore allowable for essentially the same reasons as claim 22.

Accordingly, as presented, claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 are allowable. It is therefore respectfully requested that the anticipation rejections be withdrawn.

With respect to paragraph six (6), claim 25 was rejected under 35 U.S.C. § 103(a) as obvious over Peinado in view of Okada, U.S. Patent No. 6,704,872.

With respect to paragraph seven (7), claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as obvious over Peinado.

With respect to paragraph eight (8), claim 35 was rejected under 35 U.S.C. § 103(a) as obvious over Peinado in view of Gurr, U.S. Patent No. 4,264,960.

With respect to paragraph nine (9), claims 37 and 46 were rejected under 35 U.S.C. § 103(a) as obvious over Peinado in view of Coley et al, U.S. Patent No. 5,790,664.

With respect to paragraph ten (10), claim 38 was rejected under 35 U.S.C. § 103(a) as obvious over Peinado in view of Flick, U.S. Patent No. 6,140,939.

As to obviousness, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As to each of the claims rejected for obviousness, these claims either depend from claim 22 or otherwise include the feature of the second processor transmitting a check result to the first processor, and are therefore allowable for essentially the same reasons as claim 22, since the secondary references do not cure – and are not asserted to cure – the critical deficiencies of the primary Peinado reference. Specifically, as explained above, Peinado does not disclose the feature in which the second processor transmits a check result to the first processor, since it only refers to transmitting a key to the first processor which can be used to

decrypt the first data. As to the claimed subject matter, because it does not send a key, it allows data transmissions to remain secure without relying on a prescribed encryption system as is required by the method of the Peinado reference.

Accordingly, as presented, claims 25, 29, 30, 35, 37, 38, and 46 are allowable. It is therefore respectfully requested that the obviousness rejections be withdrawn.

New dependent claims 47 and 48 do not add any new subject matter and are supported by the present application. Claims 47 and 48 depend from claim 22, and are therefore allowable for the same reasons as claim 22.

Still further, claim 47 provides that the check result transmitted by the second processor is not used to process the first data. The method of Peinado requires the second processor to transmit a key that must be used to decrypt the first data so that the first data may be processed (see column 3 lines 50-54). Accordingly, claim 47 is allowable for this further reason.

As further regards claim 48, it provides that the check result transmitted by the second processor is Boolean. The Peinado reference requires the second processor to transmit a key (see column 3 lines 50-54), which cannot be a Boolean signal. Accordingly, claim 48 is allowable for this further reason.

It is therefore respectfully submitted that claims 22 to 48 are allowable.

Conclusion

It is therefore respectfully submitted that all of pending and considered claims 22 to 48 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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